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EXAMINER

QURESHI, SHABANA

ART UNIT PAPER NUMBER

2155

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/741,285

Applicant(s)

SCHNEIDER, ROBERT

Examiner

Shabana Qureshi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

JR

DETAILED ACTION

Response to Amendment

Applicant's main argument is Lippman does not disclose, teach or suggest dynamically and automatically appending feedback information and embedding a personal identifier of the requesting user in the feedback information.

Examiner respectfully disagrees with the Applicant's allegation. Lippman's teachings of "... a feedback generator (column 2, lines 33-38)... configured to dynamically append feedback information to the received content before forwarding the content to a requesting user (column 2, lines 29-33; column 8, lines 1-20, 48-59) and... to embed a personal identifier of the requesting user in the feedback information that uniquely identifies the requesting user (column 6, lines 4-14) to allow the system to allow to automatically identify users sending feedback information back to the system (column 8, lines 1-20)" clearly teach applicant's claimed invention. For the argument on automatically, Examiner wants to point out *In re Venner* case "AUTOMATIC OR MANUAL ACTIVITY".

AUTOMATIC OR MANUAL ACTIVITY

In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed."

The court held that broadly providing an automatic or mechanical means to replace

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a manual activity which accomplished the same result is not sufficient replace a manual activity to distinguish over the prior art.)

For the above reason, Examiner believes that her rejection should be sustained.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 - 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "A system" in the claim, claim 11 recites the limitation "A method" and claim 21 recites "a storage medium" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites a system rather than a computer-implemented system, claim 11 recites a method rather than a computer-implemented method and claim 21 recites a storage medium rather than a storage system usable in computer system. These claim do not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. The use of a computer is not evident in the claim. MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

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Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either:

- (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or
- (B) be limited to a practical application within the technological arts.

Claims 1 - 22, in view of the above-cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. The use of a computer has not been indicated.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lippman (US Patent No. 6,544,042).

In regards to claim 1, Lippman teaches a system comprising:

- a plurality of content providers (column 1, lines 33-35); and
- one or more content handlers distributed throughout a network and coupled to one or more of the plurality of content providers through the network, to receive content from one or more content providers (column 1, lines 46-55); and
- a feedback generator coupled to the content handlers and configured to dynamically and automatically append feedback information to the received content before forwarding the content with appended feedback information to a requesting user (column 2, lines 26-38) and further configured to embed a personal identifier of the requesting user in the feedback information that uniquely identifies the requesting user (column 6, lines 4-14) to allow the system to identify users sending feedback information back to the system (column 8, lines 1-20).

Although Lippman teaches the "Practice Test Company" to be accessible by the Internet which contains many content providers, and suggests that the system disclosed is kept on a content handler, Lippman does not explicitly state that the system comprises of many different content handlers. However, Lippman teaches that recommended study aids may be accessed through feedback provided by the system disclosed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the services by "Practice Test Company" using many content handlers so that study aids may be accessible from many websites that can profit from sales.

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As per claim 2, Lippman teaches the system according to claim 1, wherein the content handlers generate feedback information based, at least in part, on the received content (column 2, lines 33-38).

As per claim 3, Lippman teaches a system according to claim 1, wherein the content handlers receive the feedback information based at least in part, on the received content (column 2, lines 33-38). However, Lippman does not explicitly state that the feedback received is from a third party. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide feedback services from many parties rather than one so that there may be more choices for the consumer.

As per claim 4, Lippman teaches a system according to claim 1, wherein the content handlers receive the feedback information from the content providers (column 2, lines 26-33, system disclosed by Lippman is interpreted to reside on content providers). Lippman does not explicitly state that the personal identifier is a bar-code that is visibly displayed on a printed document containing by the feedback information. However, it was common and well known to one of ordinary skill in the art at the time the invention was made that a bar-code is a method used to identify an object. It was also common and well known in the art at the time the invention was made that documents may be printed from a computer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the document bearing the feedback information with the bar code printed on it.

As per claim 5, Lippman teaches a system according to claim 1, the content providers comprising:

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- formatting services, to receive content from a content provider and generate feedback information to append to the received content based, at least in part, on the received content (column 2, lines 29-33).

As per claim 6, Lippman teaches the system according to claim 1, wherein the feedback information is a form which the requesting user can manipulate to automatically order product, services and/or content from one or more of the plurality of content providers or purveyors associated with the feedback information (column 2, lines 60-63).

As per claim 7, Lippman teaches a system according to claim 1, wherein the feedback information, regardless of source, is related to the content of the received content (column 2, lines 29-33).

As per claim 8, Lippman teaches a system according to claim 1, further comprising:
a computing device, the computing device including,

- a storage device having stored therein a plurality of executable instructions (column 10, lines 40-63); and
- an execution unit, coupled to the storage device, to execute at least a subset of the plurality of executable instructions to implement one or more of the content handlers (column 10, lines 40-63).

As per claim 9 Lippman teaches a system according to claim 1, wherein the content handler receives user modified feedback content and initiates an action based, at least in part on the user-modified feedback content (column 5, lines 8-22).

As per claim 10, Lippman teaches a system according to claim 9, wherein the action reflects the user- modified feedback content and may include one or more of ordering a product, issuing

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a request to a content provider for additional information, scoring an exam and reporting results to the user and/or content provider, and the like (column 8, lines 1-20; column 8, lines 48-59).

As per claim 11, Lippman teaches a method comprising:

- receiving content from a content provider from a network while in route to a requesting user in response to a request for such content (column 8, lines 1-20; column 8, lines 48-59); and
- appending feedback content to the received content before forwarding the received content with appended feedback content to the requesting user (column 8, lines 1-20; column 8, lines 48-59); and
- embedding a personal identifier of the requesting user in the feedback information that uniquely identifies the requesting user (column 6, lines 4-14) to allow the system to identify users sending feedback information back to the system (column 8, lines 1-20).

As per claim 12, Lippman teaches a method according to claim 11, wherein appending feedback content comprises:

- generating feedback content based, at least in part, on the received content (column 8, lines 1-20; column 8, lines 48-59); and
- inserting the feedback content in to the received content in accordance with formatting preferences of the content provider (column 8, lines 1-20; column 8, lines 48-59).

As per claim 13, Lippman teaches a method according to claim 11, wherein

- appending feedback content comprises receiving feedback content (column 8, lines 1-20; column 8, lines 48-59); and

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- inserting the feedback content in to the received content in accordance with formatting preferences (column 8, lines 1-20; column 8, lines 48-59).

Lippman does disclose on line 13 of column 5 that the feedback content may be from “partner vendors”. Lippman does not explicitly disclose that a third party provides the feedback content. However, it would be obvious to one of ordinary skill in the art at the time the invention was made to provide the feedback content from third party content providers so that partner vendors may be used (column 5, line 13).

As per claim 14, Lippman teaches a method according to claim 11, wherein appending feedback content comprises:

- receiving feedback content from the content provider (column 8, lines 1-20; column 8, lines 48-59); and
- inserting the feedback content in to the received content in accordance with formatting preferences of the content provider (column 8, lines 1-20; column 8, lines 48-59).

As per claim 15, Lippman teaches a method according to claim 11, wherein the feedback content comprises an interactive form, enabling a user to respond to the feedback content (column 8, lines 48-59).

As per claim 16, Lippman teaches a method according to claim 15, wherein the interactive form is an examination over material covered in the received content (column 2, lines 29-33).

As per claim 17, Lippman teaches a method according to claim 15, wherein the interactive form is a request for further information regarding the received content (column 8, lines 48-55).

As per claim 18, Lippman teaches a method according to claim 11, further comprising:

- receiving user-modified feedback content from the user (column 8, lines 48-59); and

- initiating an action on behalf of the user based, at least in part, on the user-modified feedback content (column 8, lines 48-59).

As per claim 19, Lippman teaches a method according to claim 18, wherein the user-modified feedback content is received at a network address determined by the feedback content generator (column 7, lines 8-23; column 8, lines 48-59). Lippman does not explicitly state that the personal identifier is a bar-code that is visibly displayed on a printed document containing the feedback information. However, it was common and well known to one of ordinary skill in the art at the time the invention was made that a bar-code is a method used to identify an object. It was also common and well known in the art at the time the invention was made that documents may be printed from a computer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the document bearing the feedback information with the bar code printed on it.

As per claim 20, Lippman teaches a method according to claim 18, wherein initiating an action comprises one or more of issuing a message to a content provider for additional information, ordering a product for delivery to the user, scoring an exam and reporting results to the user and/or generator of the feedback content, and the like (column 8, lines 1-20; column 8, lines 48-59).

As per claim 21, Lippman teaches a storage medium comprising a plurality of executable instructions at least a subset of which, when executed, implement a content handler with integrated feedback facilities, to receive content from one or more content providers from a network while in route to a requesting user, and to append feedback content to the received content and forwarding the combined content to the requesting user (column 7, lines 5-25).

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As per claim 22, Lippman teaches a storage medium according to claim 21, wherein the content handler includes a feedback content generator, to dynamically generate feedback content to append to received content based, at least in part, on the received content (column 7, lines 5-25).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shabana Qureshi whose telephone number is (703) 308-6118. The examiner can normally be reached on Monday - Friday, 8:30am to 5pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shabana Qureshi
Examiner
Art Unit 2155

SQ
February 18, 2005


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER